

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN P. CAPPS
and ERNEST H. BEERNINK

Appeal No. 97-0191
Application 08/331,151¹

ON BRIEF

Before HAIRSTON, KRASS and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4 and 7-38, all of the claims pending in the application. Claims 5 and 6 have been canceled. An amendment after final rejection

¹ Application for patent filed October 28, 1994. According to appellants, this application is a continuation of Application of 08/117,431, filed September 7, 1993.

was filed October 20, 1995 and was denied entry by the Examiner.

The disclosed invention relates to the entry of handwritten input to a pointer-based computer system which is analyzed and identified as recognized text words or unrecognized “ink” words. These words are formatted into paragraphs which are displayed on a display screen by adjusting the positions of the words relative to each other.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of formatting handwritten input entered in a pointer-based computer system having a display screen on which the path of the pointer is displayed as ink, the method comprising the following steps:

analyzing the handwritten input with a word recognizer to identify some parts of the handwritten input as recognized text words and unrecognized ink words being displayed on the display screen in their handwritten input form and the recognized text words appearing in a standard font;

grouping the recognized text words and the unrecognized ink words into one or more paragraphs containing both a recognized text word and an unrecognized ink word;

formatting the recognized text words and unrecognized ink words by adjusting their positions with respect to one another within the one or more paragraphs so that the paragraphs have one or more lines, at least one of which has a plurality of words, wherein the words in each line are separated from one another by defined word separation distances; and

displaying the formatted paragraphs on said display screen such that both unrecognized ink words and recognized text words are contiguously displayed in the same paragraphs, the unrecognized ink words being displayed in their handwritten input form and the recognized text words being displayed in a standard font within the formatted paragraphs, wherein the steps of analyzing, grouping, and formatting are performed by said computer system.

Appeal No. 97-0191
Application 08/331,151

The Examiner relies on the following references:

Sklarew	4,972,496	Nov. 20, 1990
Norwood	5,063,600	Nov. 05, 1991

Claims 1-4, 7-10, and 15-35 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Sklarew. Claims 11-14 and 36-38 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Sklarew in view of Norwood.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief² and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure of Sklarew does not fully meet the invention as recited in claims 1-4, 7-10, and 15-35. We are also of the view that the

² The Reply Brief filed May 28, 1996 was considered by the Examiner as not being limited to new points of argument or to new grounds of rejection and was not entered. Accordingly, the arguments in such Reply Brief have not been considered in this appeal.

evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention set forth in claims 11-14 and 36-38.

Accordingly, we reverse.

We consider first the rejection of claims 1-4, 7-10, and 15-35 under 35 U.S.C. § 102(b) as anticipated by Sklarew. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1, 25, and 31 which are directed to the display of formatted paragraphs having both recognized text words and unrecognized ink words, the Examiner attempts to read the various limitations on the Sklarew reference (Answer, pages 4-6). In response, Appellants argue several alleged distinctions over Sklarew including the contention (Brief, page 11) that Sklarew does not display recognized text words and unrecognized handwritten words grouped together in the same paragraph as claimed.

Upon careful review of the Sklarew reference and the arguments of record, we are in agreement with Appellants' stated position in the Brief. In our view, Appellants are correct in their

assertion that the Figures 11A-11I illustrations in Sklarew relied on by the Examiner disclose that the handwritten ink strokes are not grouped together with text words into paragraphs. It is only after the handwritten words are recognized in Sklarew that they are grouped into the existing paragraphs and then only in text form with the handwritten strokes no longer appearing on the display. Since the claimed feature of displaying formatted paragraphs having contiguous handwritten and text words in the same paragraph is not disclosed in Sklarew, it is our opinion that the Examiner's 35 U.S.C. § 102(b) rejection is not well founded.

We find the Examiner's reasoning deficient as well with respect to independent claim 15 which is directed to the feature of replacing existing words and/or inserting words into a displayed paragraph. In the responsive arguments portion at pages 15 and 16 of the Answer, the Examiner asserts that Figures 11A-11I, 12, and 13 and the accompanying description in Sklarew disclose the intersecting and overlapping bounding box features as claimed. We do not agree. To the extent that any bounding box feature can be construed to exist in Sklarew, we can find no teaching or suggestion of any determination as to replacing or inserting words dependent on the extent of overlapping of such bounding boxes with the bounding boxes of existing words as claimed.

In view of the above discussion, we cannot sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1, 15, 25, and 31, nor of claims 2-4, 7-10, 16-24, 26-30, and 32-35 which depend therefrom.

We now consider the rejection of claims 11-14 and 36-38 under 35 U.S.C. § 103 as being unpatentable over Sklarew in view of Norwood. From the Examiner's statement of the rejection (Answer, pages 7-9), it is apparent that Norwood was applied for the sole purpose of addressing the claimed paragraph editing and modification features which the Examiner found lacking in Sklarew. The Norwood reference is directed to the annotation of text documents with handwritten notes; however, we can find no teaching or suggestion of editing existing text or insertion of text into existing paragraphs. Our review of Norwood reveals no disclosure that would overcome the innate deficiencies of Sklarew and, therefore, we do not sustain the obviousness rejection of claims 11-14 and 36-38.

Appeal No. 97-0191
Application 08/331,151

In summary, we have not sustained either of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-4 and 7-38 is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

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Appeal No. 97-0191
Application 08/331,151

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